

REMARKS

Applicant notes with appreciation the Examiner's allowance of Claims 9-11, 35-41, 43, 45-48 and 53-54, provided that these claims are rewritten in independent form to include all limitations of the base claim from which these claims depend, plus any intervening claims. Applicant believes that its arguments below will persuade the Examiner to allow the base claims from which these claims depend. Accordingly, prior to amending the foregoing claims to place them in condition for allowance as recommended by the Examiner, Applicant will first take this opportunity to respond to the Office Action of November 11, 2004 regarding certain prior art characterizations by the Examiner. For the reasons discussed below, Applicant requests reconsideration of the claims herein

I. MATTER UNRELATED TO OFFICE ACTION

Applicant hereby informs the Examiner that the Attorney Reference Number with respect to this application has been changed from 2272/025 to 4828/002. Applicant requests that the Examiner make a note of this change for future reference to this file.

II. CLAIM OBJECTIONS

The Examiner has objected to Claims 13-16, 21 and 22 under 37 C.F.R. 1.75(c) as being of improper dependent form for failing to further limit the subject matter of previous claims. With respect to claims 13-16, the Examiner has indicated that these claims have not been considered in this Office Action due to the improper dependency. However, the Examiner has indicated that claim 21 has been considered as if dependent on claim 20. Based on the foregoing, Claims 13-16 have been amended to set forth proper dependency and therefore may now be considered. In particular, Claims 13, 15 and 16 now depend from Claim 12, and Claim 14 depends from Claim 13. In order to cure this improper dependency, Claim 21 has also been amended to depend on claim 20, as already considered by the Examiner. Claim 22 requires no further amendment to address the objection.

With respect to Claim 20, the Examiner indicated that the phrase "can be" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. Accordingly, Applicant has amended Claim 20 to delete the phrase "can be disengaged only from" and replaced that phrase with "are capable of disengagement from only".

The Examiner also notes that Claim 49 recites "said strap" in line 1 of the claim. Applicant believes that the Examiner was referring to Claim 51 (rather than Claim 49), which recites "said strap" in line 1. Assuming that the Examiner was referring to Claim 51, Applicant

accepts the Examiner's conclusion that Claim 51 was intended to depend from Claim 49 and not Claim 50, and Claim 51 has been amended accordingly.

III. CLAIM REJECTIONS UNDER 35 U.S.C. § 102

The Examiner has rejected Claims 2, 6, 12, 17 and 19 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 4,632,138 ("Irwin"). In a separate rejection, the Examiner has rejected Claims 29, 30, 42, 44, 49 and 51 under 35 U.S.C. §102(b) as also being anticipated by Irwin.

An invention is anticipated under §102 if the same device, including all the claim limitations, is shown in a single prior art reference. *Manual of Patent Examining Procedure*, § 2131 – *Anticipation, Application of; Richardson v. Suzuki Motion Co. Ltd.* 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989). Every element of the claimed invention must be literally present, arranged as in the claim. *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 894, 221 USPQ 669, 973 (Fed. Cir. 1984) *cert. denied*, 469 U.S. 857 [225 USPQ 792] (1984); *Kalman v. Kimberly Clark Corp.*, 713 F.2d 760, 771-772, 218 USPQ 781, 789 (Fed Cir. 1983) *cert. denied*, 465 U.S. 1026 [224 USPQ 250] (1984). The identical invention from the prior art must be shown in as complete detail as is contained in the patent claim. *Manual of Patent Examining Procedure*, § 2131 – *Anticipation, Application of; Jamesbury Corp. v. Litton Industrial Products, Inc.*, 756 F.2d 1556, 1560, 225 USPQ 253, 256 (Fed. Cir. 1985); *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983). For the reasons discussed below, Applicant requests that the Examiner reconsider the rejection of the claims under § 102, since that Section's requirements are not met by Irwin.

A. **Claims 2, 6, 12, 17 and 19**

Applicant respectfully submits that independent claim 2 defines structure not identically found in the cited prior art. In particular, notwithstanding the Examiner's assertion to the contrary, Irwin fails to teach separate structures comprising (a) a plurality of coupling members and (b) a plurality of attachment members, which are separately recited in Claim 2. Indeed, the Examiner equates the "coupling members" recited in Claim 2 to "hook-and-thistle type fasteners (40)" described in Irwin; and the "fastening members," which are also recited in Claim 2, to a "hook strip (42)" and "thistle strip (43)" taught in Irwin. It is respectfully submitted that the hook and thistle strips (42, 43) define the same exact structure as the hook-and-thistle fasteners (40), insofar as the strips, which are integrated into the fasteners, are what cause the fasteners to be labeled "hook-and-thistle fasteners." See, Column 6, lines 1-22. Accordingly, Irwin cannot be

used to teach (under §102) both the coupling members and fastening members recited in Claim 2.

Further, should the Examiner maintain that Irwin does in fact teach two separate structures comprising "coupling members" and "attachment members," Irwin still fails to disclose "a plurality of attachment members selectively connected to said plurality of coupling members," as further required by Claim 2. Since the hook-and-thistle strips (42, 43) in Irwin (which are equated by the Examiner to Applicant's "attachment members") are always connected to the hook and thistle fasteners (40) (which are equated by the Examiner to Applicant's "coupling members"), Applicant submits that the Irwin fails to disclose attachment members that are "selectively connected" as required by Claim 2, which sets forth that the attachment members may be disconnected from said coupling members and that they are only connected to each other some of the time.

Applicant further submits that Claim 6 also defines structure not found in the sole §102 reference. In particular, the Examiner considers Irwin's terminal end panels (14') comparable to the access means recited in Applicant's Claim 6. While the terminal end panels (14') in Irwin do appear to provide for access to an interior of the portable shelter when those panels are in an open position, the access means in Irwin does not comprise "an opening in said section of material," as required by Claim 6 (i.e., one does not have access into the interior of the shelter through a section of the material itself).

Based on the foregoing, Applicant submits that Claims 2 and 6 are presently allowable over the cited prior art. Since Applicant's Claims 12, 17 and 19 depend from Claim 2, which has now been distinguished from the prior art, these claims should be allowed as well. Applicant further submits that if one or more of Applicant's arguments relating to Claim 2 are persuasive, the Examiner need not consider Applicant's argument with respect to Claim 6, since Claim 6 depends directly from Claim 2.

B. Claims 29, 30, 42, 44, 49 and 51

The Examiner has also rejected Claim 29 based on the Irwin disclosure. However, Applicant is somewhat puzzled by this rejection since the rejection refers to elements not recited in Claim 29. In particular, the Examiner contends that Irwin discloses a "security apparatus including a section of material (12), a plurality of pairing members (13), an access means (14'), a plurality of fastening members (40) connected to the material (12) and connected to the coupling members (40) and vertical/horizontal supports (21,22)...."

It is respectfully noted that Applicant's Claim 29 does not recite "an access means" as in

independent Claim 2. Based on the context of the rejection, Applicant presumes that the Examiner intended to compare the terminal end panels (14') in Irwin to the "means for entrance and exit" recited in Claim 29. However, Applicant requests confirmation that this is what the Examiner intended so that a proper response can be formulated.

Furthermore, the Examiner also refers to "coupling members (40)" which are similarly not recited in Claim 29. From the context of the Examiner's comments, it is unclear what the Examiner meant by referring to "coupling members (40)." Based on the foregoing, Applicant requests clarification of the Examiner's rejection before responding thereto.

With respect to Claims 30, 42, 44, 49 and 51, which all depend directly or indirectly from Claim 29, Applicant cannot respond to the Examiner's rejections until clarification is provided with respect to the elements referred to in rejecting Claim 29 but which are not actually present in that claim.

Moreover, although page 3 of the Office Action refers to Claims 29, 30, 42, 44, 49 and 51, the Examiner's reasoning on the rejection found on the top of page 4 of the Office Action refers to Claim 50, instead of Claim 51. Since page 3 of the Office Action refers to Claim 51 and since line 1 of Claim 51 refers to "loops" which the Examiner mentions on the second line of page 4 of the Office Action, Applicant believes that the Examiner was actually referring to Claim 51 and not Claim 50 when discussing the rejection on page 4 of the Office Action.

In connection with the foregoing, Applicant has also noticed that Claim 50 was neither formally rejected nor allowed. Accordingly, Applicant requests a determination with respect to Claim 50 in order to provide a meaningful response.

Concluding Applicant's responses to the Examiner's rejections under 35 U.S.C. §102, Applicant submits that Claims 2 and 6 are patentably distinguishable over the cited prior art for the reasons discussed above. Since Claims 12, 17 and 19 depend from Claim 2, these claims should be allowed as well. With respect to Claims 29, Applicant will await clarification on the Examiner's rejection. Since Claims 30, 42, 44, 49 and 51 depend from Claim 29, Applicant will also wait to respond until clarification is provided with respect Claim 29. Finally, Applicant requests a determination on Claim 50, which was neither allowed nor rejected by the Examiner.

IV. CLAIM REJECTIONS UNDER 35 U.S.C. § 103

It is well established that the Examiner bears the initial burden of demonstrating a *prima facie* case of obviousness under §103. *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976). To this end, the *prima facie* case requires, *inter alia*, some suggestion or motivation to

modify or combine the references based upon the prior art or a general knowledge in the field. *Manual of Patent Examining Procedure*, § 2143 *Basic Requirements of Prima Facie Obviousness*; *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998). "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure." *Manual of Patent Examining Procedure*, § 2143 *Basic Requirements of Prima Facie Obviousness* (citing *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q. 2d 1438 (Fed. Cir. 1991)). Statements in the prior art, as well as the inferences that those skilled in the art would be reasonably expected to draw therefrom, may form the basis of such suggestions. *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA1968). However, the mere fact that an apparatus is capable of being modified to perform a claimed feature is insufficient as a basis for a non-obvious rejection without some suggestion to do so. *In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430 (Fed. Cir. 1990). "[A]n examiner cannot establish obviousness by located references which describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done." *Ex parte Levengood*, 28 USPQ2d 1300, 1301 (Bd. Pat. App. & Int. 1993).

A. Claims 3 and 4

The Examiner has rejected Claims 3, 4 and 18 under 35 U.S.C. §103 based on the disclosure of Irwin. In particular, with respect to Claims 3 and 4, the Examiner acknowledges that Irwin fails to disclose tear-resistant material or the use of Kevlar. However, in light of the disclosure in Irwin of nylon, plastic and canvas it would supposedly be obvious to use tear-resistant material or Kevlar in connection with Applicant's apparatus. It is respectfully submitted that on this issue the Examiner has not made a prima facie case of obviousness with respect to Claim 4, which requires material comprising Kevlar. Contrary to the Examiner's assertion, it is not simply a matter of design choice to use Kevlar in connection with the apparatus. In addition to the heat considerations noted by the Examiner which are inherent to Kevlar, Kevlar has another key advantage over the nylon, plastic and canvas covers which are disclosed in Irwin. In particular, while nylon, plastic and canvas are easily cut and separated with conventional cutting means, such as a knife or scissors, Kevlar is "cutproof," meaning that it cannot be penetrated or cut with conventional cutting means or by conventional cutting methods. Accordingly, using Kevlar in connection with Applicant's apparatus is particularly advantageous since it would provide added protection in preventing pilferers from entering a booth when the Applicant's apparatus is in use, even were the pilferers to be in possession of a knife or other

conventional cutting means. In Irwin, the key reason for using nylon, plastic or canvas is for their water-repellent properties (column 9, line 18), not for added protection from conventional cutting means. Based on the foregoing, Applicant submits that the use of Kevlar is non-obvious over the cited prior art, i.e., Irwin. In connection with this response, Applicant has also amended Claim 3 to include the phrase "that is cutproof" to further distinguish Claim 3 over the cited prior art.

B. Claim 5

The Examiner has also rejected Claim 5 under 35 U.S.C. §103 based on the disclosure of Irwin in view of U.S. Patent 5,680,893 ("Neer"). In particular, the Examiner states that Irwin discloses the basic apparatus, except fails to disclose that the material used is "opaque." In response to this objection, Applicant submits that there is simply no suggestion anywhere in the cited references to combine the structure of Irwin with the opaque feature of Neer. As noted above, the fact that an apparatus is capable of being modified to perform a claimed feature is not a sufficient basis to assert an obviousness rejection absent a suggestion to actually combine the references. In this case, one of the purposes of the apparatus disclosed in Irwin is to provide a portable shelter from which hunters and wildlife may pursue and observe their game. Accordingly, using opaque material to comprise the cover section in Irwin could potentially be counterproductive insofar as a hunter or photographer could be noticed more easily by their prey if even a somewhat light-transmissive material were used. Indeed, the goal of hunters using an Irwin-type structure is to stay predominantly concealed while stalking their prey. Accordingly, there appears to be no suggestion to combine basic structure of Irwin with the opaque material disclosed in Neer, and in fact doing so would render Irwin virtually useless.

C. Claims 7, 8 and 52

The Examiner has also rejected Claims 7, 8 and 52 under 35 U.S.C. §103 based on the disclosure of Irwin in view of U.S. Patent 5,010,909 ("Cleveland"). The Examiner asserts that Irwin discloses the basic apparatus, but omits a zippered access, which is disclosed in Cleveland. Again, Applicant respectfully submits that there is certainly no suggestion and no apparent motivation to combine the basic structure in Irwin with the zippered access disclosed in Cleveland. Irwin discloses a structure comprising panels, wherein each of said panels comprises a four-sided frame with material disposed within each frame. Providing Irwin's material with a large enough zippered access, wherein the zipper extends to the bottom edge of the material for persons to enter and exit, as shown in Cleveland (see Figs. 1 and 2), would

cause the resultant device in Irwin to become unmanageable, since the material would be required to be disconnected from the frame near the hypothetical zippered access, thus undermining the very purpose of Irwin, which is to provide a structure that is capable of rapid assembly and which may be folded into a compact unit for convenient transport (column 2, lines 44-52). Accordingly, it would be counterproductive to equip the structure of Irwin with the zippered access disclosed in Cleveland.

D. Claims 20 – 28

The Examiner has rejected Claims 20 - 28 under §103 based on Irwin in view of Neer. With respect to Claim 20, Applicant is once again perplexed by the Examiner's rejection, since the rejection refers to elements not recited in Claim 20. In particular, the Examiner contends that Irwin discloses a "security apparatus (10) including a section of material (12) having two sides, a plurality of edges (32), a top and bottom (both unlabeled); an access means 914' [sic], a plurality of securing means (40) connected to the material (12); and a plurality of attachment members (42,43) connected to the securing means (40) and vertical/horizontal supports (21/22) wherein the attachment members (42,43) permit faste4ning [sic] and unfastening only from one side of the material (12), see figure 4."

While there appears to be somewhat of an overlap between the Examiner's rejection and Applicant's Claim 20, it is respectfully submitted that Applicant's Claim 20 still differs quite substantially from the elements referred to in the Examiner's rejection of Claim 20 on page 6 of the Office Action. Accordingly, Applicant requests clarification of the Examiner's rejection before responding thereto.

With respect to Claims 21 – 28, which all depend directly or indirectly from Claim 20, Applicant cannot respond to the Examiner's rejections until clarification is provided with respect to the elements referred to in rejecting Claim 20 but which are not actually recited in that claim.

Claims 31 – 34

As with Claims 30, 42, 44, 49 and 51 which are discussed in Section III. B. above (addressing the Examiner's §102 rejections), Applicant cannot respond to the Examiner's rejections of Claims 31 – 34, which all depend directly or indirectly from Claim 29, until clarification is provided with respect to the elements referred to in rejecting Claim 29 but which are not actually recited in that claim.

Concluding Applicant's responses to the Examiner's rejections under 35 U.S.C. §103,

Applicant submits that Claims 3, 4, 5, 7, 8 and 52 are allowable over the cited prior art, since neither Irwin above, nor the Irwin-Neer or Irwin-Cleveland combinations provide bases for the obviousness rejections present by the Examiner as to these claims. Furthermore, since Applicant's Claims 3, 4, 5, 7 and 8 depend either directly or indirectly from Claim 2, which has now been distinguished from the prior art (as discussed in the §102 section of this response), these claims should be allowed on that basis as well. Applicant further submits that if one or more of Applicant's arguments relating to Claim 2 are persuasive, the Examiner need not consider Applicant's arguments with respect to the claims which depend therefrom. Furthermore, Applicant requests clarification of the rejection of Claim 20 (and Claims 21 – 28) so that Applicant can respond thereto. Finally, Applicant will also await clarification of the rejection with respect to Claim 29 so that Applicant can respond to the rejections of Claims 31 – 34.

V. CONCLUSION

Based on the foregoing, it is respectfully submitted that the claims are patentably distinguishable over the prior art, subject to clarification by the Examiner of certain claims as requested by Applicant herein, and that the subject application is in condition for allowance.

Respectfully submitted,

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CERTIFICATE OF EXPRESS MAIL

I hereby certify that the following documents are being deposited with the United States Postal Service, Express Mail, Post Office to Addressee in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria Virginia 22313-1450 on the date below.
(Express Mail Label No.: EV 602520901 US)

- 1) Amendment And Response To Office Action (15 pages);
- 2) Petition for Extension of Time under 37 CFR 1.136(a);
- 3) Check for \$ 510.00 to cover the petition fee under 37 CFR 1.17(a)(3); and
- 4) Return Receipt Postcard.

Date: May 4, 2005

Dahlia A. Bowie